IN THE

Supreme Court of the United States

October Term, 1948.

No. 372

LeRoy J. Leishman,

Petitioner,

vs.

Radio Condenser Company and General Instrument Corporation,

Respondents.

PETITION FOR WRIT OF CERTIORARI AND BRIEF IN SUPPORT THEREOF.

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LEROY J. LEISHMAN,

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RADIO CONDENSER COMPANY and GENERAL INSTRUMENT CORPORATION,

Respondents.

PETITION FOR WRIT OF CERTIORARI.

To the Honorable Supreme Court of the United States:

Your petitioner respectfully shows:

Summary Statement of Matter Involved.

Radio Condenser Company and General Instrument Corporation, respondents herein, brought this suit under the Declaratory Judgment Act in the United States District Court for the Southern District of California, against petitioner, a resident within the said district and the owner of U. S. patent No. 20,827 [R. Vol. II, pp. 168 *et seq.*].

Respondents alleged that petitioner had filed a suit against The Richards and Conover Company, Civil Action No. 2155, in the U. S. District Court for the Western

District of Oklahoma alleging that the said company had infringed claims 7 to 11 of his patent No. 20,827 through the sale of Motorola radio receiving sets containing automatic tuning devices embodying the invention covered by the said claims.

Respondents further alleged among other things that they were the manufacturers of the said automatic tuning devices; that the said claims of petitioner's patent were invalid; and that the said automatic tuning devices did not infringe the said claims [R. Vol. I, pp. 2 *et seq.*].

Petitioner's answer denied that the said claims were invalid and that they were not infringed by respondents' tuners [R. Vol. I, pp. 15 *et seq.*] and a counter claim was filed praying for damages and an injunction [R. Vol. I, pp. 16 *et seq.*].

Subsequently, on January 23, 1946, respondents moved for summary judgment of non-infringement [R. Vol. I, pp. 27 *et seq.*] on the ground that their automatic tuners were the same patentwise as the tuners which the Ninth Circuit Court of Appeals held did not infringe the said claims in *Leishman v. Associated Wholesale Electric Company,* 137 F. 2d 722. The *Associated* decision, upon which respondents thus relied, held that the accused tuners, which were operated by plungers instead of levers as shown in the patent, did not infringe because the plungers were not equivalents of the levers. None of the claims at issue called for levers, but the appellate court in the *Associated* case ruled that the claims of the reissue patent were not for the same invention as the original patent unless they included levers. The court explained in footnote 12 that this conception of the original patent was arrived at by omitting original claim 5, which did not include

levers, the court saying that "both the original and reissue patents must be construed as if claim 5 had never been included in either," because this broad claim had been disclaimed *from the reissue*. The court accordingly considered whether plungers and levers were equivalents for operating the tuners, but ruled that they were not.

The record in the *Associated* case was silent as to whether plungers and levers were known equivalents for operating automatic tuners. It did not include any prior art tuner patents that were operated by plungers. In the three prior art tuner patents that were of record, the illustrative embodiment showed levers as the operating members.

Petitioner opposed the motion for summary judgment, supporting his affidavit with ten patents and sixteen sets of pictures showing that plungers and levers were well known equivalents for operating automatic tuners and other widely used mechanisms at the time of the grant of the original patent of which the patent in suit is a reissue.

Petitioner's affidavit stated that none of this evidence of the equivalency of levers and plungers was presented in evidence in the *Associated* case [R. Vol. I, p. 48], and the motion was opposed on the ground that the decision in the *Associated* case could therefore not be followed in the present case because the evidence was different and showed the previous decision to be in error.

On June 10, 1946, the U. S. District Court for the Western District of Oklahoma, after a full trial, entered judgment in petitioner's favor in *The Richards and Con-*

over case, *supra,* to the effect that the same claims here at issue are good and valid in law and that the defendant in the Oklahoma case had infringed them through the sale of Motorola sets containing the accused tuners [R. Vol. I, pp. 60 *et seq.*]. Finding 26 in the Oklahoma case identified these tuners as the products of the respondents in the instant action [R. Vol. I, p. 59], and Finding 27 stated that "the tuners referred to in Finding 26 do not differ in any essential respect, so far as the question of infringement is concerned, from the tuner" which was the accused device in the *Associated* case, *supra* [R. Vol. I, p. 59].

Petitioner filed a motion for permission to amend his answer in the instant case [R. Vol. I, pp. 72 *et seq.*] to make the additional defense that respondents were bound by the judgment in the Oklahoma case because of their participation therein, but the court denied the motion [R. Vol. I, p. 134].

On September 12, 1946, the District Court in the instant case entered *summary* judgment holding that the claims here at issue were *not* infringed by respondents' automatic tuners, the said *summary* judgment being in direct conflict with the prior judgment of the U. S. District Court for the Western District of Oklahoma, which held after a full trial that the same tuners were clear infringements [R. Vol. I, pp. 94 *et seq.*].

On May 4, 1948, the Court of Appeals for the Ninth Circuit affirmed the summary judgment of the lower court

[R. Vol. III, pp. 258 *et seq.*], and on June 3, 1948, it denied a petition for a rehearing [R. Vol. III, p. 268].

The decision of the court of appeals modified the injunction of the lower court so that petitioner is now enjoined from enforcing the Oklahoma judgment against Galvin Manufacturing Company which assumed the defense of the Oklahoma action and manufactured the radio sets embodying the tuners involved in that suit.

On August 14, 1948, the Hon. William O. Douglas, Associate Justice of this Honorable Court, extended the time for filing this petition for a writ of certiorari up to and including October 30, 1948 [R. Vol. III, p. 273].

The defendant in the Oklahoma case appealed from the judgment of the lower court, and a hearing was held before the Court of Appeals for the Tenth Circuit on September 13, 1948.

The Supreme Court Has Jurisdiction to Review the Decision of the Court of Appeals for the Ninth Circuit.

Petitioner relies upon Section 240 of the Judicial Code, corresponding to Title 28, U. S. C. A., paragraph 1254, and also Rule 38(5b) of the Rules of the Supreme Court. If the Court of Appeals for the Tenth Circuit affirms the decision of the U. S. District Court for the Western District of Oklahoma in the case of *Leishman v. The Richards and Conover Company*, Appeal No. 3577, there will be a direct conflict between two Courts of Appeals as to

whether respondents' automatic tuners infringe claims 7 to 11 of petitioner's patent No. Re 20,827. In that event, Rule 38(5b) of this Honorable Court will be applicable, and this Honorable Court should resolve the conflict.

Although judgment was entered in the Oklahoma case before the summary judgment was entered in the instant action, delays in printing caused the hearing before the Tenth Court of Appeals to be held after the Ninth Court of Appeals had rendered its opinion herein. Even though the time for filing this petition was extended for the maximum permissible period, it nevertheless has become necessary to file this petition before the Tenth Court of Appeals has acted in the earlier case. This Honorable Court will be immediately advised of the action of the Court of Appeals for the Tenth Circuit. Upon investigation, it appears the Court of Appeals for the Tenth Circuit usually renders decisions in about two months after submission; thus a decision from that Court may be expected about November 13, 1948. The present conflict is thus between a Court of Appeals and a district court in another circuit. It is therefore requested that this Honorable Court defer action on this petition until the Court of Appeals of the Tenth Circuit has rendered its opinion, or, perferably, that this petition be granted without regard to any action of the Tenth Court of Appeals because of the nature of the questions presented which bring this case within the provisions of Rule 38(5b) irrespective of a conflict between circuits.

The Questions Presented.

1. Can infringement of the claims at issue be avoided by using a plunger instead of a lever to operate or transmit motion to the elements within the radio set that do the actual work of petitioner's combination?

2. Is it proper for a federal court to grant a *summary* judgment in direct conflict on identical issues with the judgment of another federal court rendered after a full trial?

3. Is it proper for a federal court to grant a *summary* judgment solely upon the basis of *stare decisis* instead of allowing the opposing party the opportunity of adducing evidence at a trial to show that the previous decision may have been in error?

4. When the patentee (the petitioner here) had already succeeded in an infringement suit in the U. S. District Court for the Western District of Oklahoma where the defense was undertaken by Galvin Manufacturing Company, a privy of the adjudged infringer, was it proper for the Court of Appeals of the Ninth Circuit to enjoin petitioner from enforcing the Oklahoma judgment against Galvin Manufacturing Company, basing such enjoinder solely on the fact that Galvin Manufacturing Company was a customer of petitioner's opponent who prevailed before the Court of Appeals of the Ninth Circuit in this later case?

5. When determining whether the reissued patent was granted for the same invention intended to have been covered by the surrendered original patent, should the original specification and claims have been construed as they appeared, at the time the original patent was sur-

rendered, or was it proper for the appellate court to ignore in original claim 5 the evidence of intent to cover the subject matter of certain *narrow* reissue claims, basing its action solely on the fact that this broad original claim was later disclaimed from the reissue?

6. Was it proper for the Court of Appeals for the Ninth Circuit to affirm the lower court in its denial of petitioner's motion to amend his answer to the complaint in order to make the additional defense that respondents were bound by the judgment in the Oklahoma case because of their participation therein?

Reasons Relied Upon for Allowance of the Writ.

1. The opinion of the Court of Appeals for the Ninth Circuit in the instant case is in conflict with that of the U. S. District Court for the Western District of Oklahoma in the case of *Leishman v. The Richards and Conover Company,* in which an appeal was recently heard by the Court of Appeals for the Tenth Circuit. If the district court's decision is affirmed (a decision is expected within a month) there will be a direct conflict between the decisions of the Courts of Appeals for the Ninth and Tenth Circuits.

2. The Declaratory Judgment Act has made it possible for manufacturers of automatic tuning devices to file declaratory judgment suits against petitioner in the Ninth Circuit, of which he is a resident, in order to secure the benefit of the decision of the Court of Appeals for the Ninth Circuit in the case of *Leishman v. Associated Wholesale Electric Company, supra,* thus making it difficult, if not impossible, for petitioner ever to obtain a second independent adjudication in another circuit. In

addition to Radio Condenser Company and General Instrument Corporation, respondents herein, General Motors Corporation has also brought a declaratory judgment suit against petitioner in the Ninth Circuit. The latter case has been tried but not yet decided. Respondents herein are the sole present manufacturers, not licensed by petitioner, of automatic tuners of the type here involved for resale as components to manufacturers of household radio receivers, and General Motors Corporation is the leading manufacturer of such tuners for automobile use. More than eight million of these tuners have already been made [Oklahoma Finding 25, Vol. I, p. 59]. A decision by this court in the instant case will thus determine these issues for all these important litigants, and this Honorable Court should therefore decide the questions here presented regardless of the outcome of the appeal now before the Court of Appeals for the Tenth Circuit. The radio industry should know where it stands with respect to the patent here involved.

3. The summary judgment herein, which has been affirmed by the Court of Appeals for the Ninth Circuit, is the first summary judgment that has ever been granted in direct conflict with the judgment of another federal court rendered after a full trial. This use of a summary judgment is contrary to the practice insisted upon by the Supreme Court and other federal courts, which have held that a summary judgment should never be granted when there is the least doubt as to what the outcome would be if a trial were held. Such use of summary judgments is a departure from the accepted and usual course of judicial proceedings.

4. The basing of a summary judgment upon the doctrine of *stare decisis,* especially when the action is filed

under the Declaratory Judgment Act, creates a situation in which infringers may rush into a patentee's circuit, after a decision has once been rendered against him, and secure rubber stamped summary judgments on the basis of *stare decisis* without the patentee ever having an opportunity to adduce evidence at a trial to show that the original decision may have been in error. This use of summary judgment is a radical and unwarranted departure from the accepted and usual course of judicial procedure.

5. In its *Associated* decision, *supra*, reaffirmed and adopted by the appellate court in its opinion in the present case, the court decided an important question of patent law in respect to reissue patents in a way that is contrary to established procedure and in conflict with the aforementioned decision of the district court in the Tenth Circuit and with the pertinent statutes themselves.

Prior to its *Associated* decision, relied upon by the appellate court in the instant case, it was recognized that reissue claims were for the same invention as the original patent, if such reissue claims came within the scope of the original claims. When a broad original claim was dropped at the time of reissue because it included too much, this did not affect the validity of narrower reissue claims. The *Associated* decision is to the effect that if the broad claim is dropped subsequent to the reissue by means of a disclaimer, then the validity of the narrower reissue claims is retroactively affected for the reason that the court may not examine the broad claim for evidence

of intent, but must construe the original patent as if it had never included the disclaimed claim. Heretofore, the effect of a disclaimer of a broad claim has only been to relinquish that portion of its scope which was in excess of the narrower claims retained. That is what the disclaimer statute provides;[1] but the *Associated* decision, reaffirmed in the instant case, makes an unauthorized and unwarranted exception to the application of both the disclaimer and the reissue statute[2] that can have far-reaching and retroactive consequences.

In petitioner's situation, dealt with in the *Associated* decision, broad original claim 5 was drawn to the essential elements of petitioner's combination and did not include any kind of an operating member whatever, it being immaterial whether the parts were operated by a lever or a plunger or some other convenient means. This broad claim was repeated in the reissue patent where the narrower claims here at issue appeared for the first time. Seventeen months after the reissue was granted it was discovered that claim 5 was broad enough to cover other

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[1]"Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, *his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented;* . . ." (Emphasis added.) Rev. Stat., Sec. 4917. (U. S. C., Title 35, Sec. 65.)

[2]"* * * Every patent so reissued, together with the corrected specifications, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; . . ." Rev. Stat., Title LX, Sec. 4916. (U. S. C., Title 35, Sec. 64.)

subject matter to which the patentee was probably not entitled. Claim 5 was accordingly disclaimed; but the narrower leverless claims, which included important structural features that were novel with the patentee, were all retained. Had claim 5 been dropped when the reissue was obtained, established federal procedure would have required that it be taken into consideration by the appellate court when examining the original patent to determine whether the reissue claims were for the same invention intended to have been claimed by the original; but because this claim was dropped by a subsequent disclaimer, the appellate court refused to consider the claim when ascertaining the patentee's original intent, saying the disclaimer "speaks from the date of the original patent." As authority for this statement, the *Associated* decision referred to footnote 7, which cited this Honorable Court's decision in *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U. S. 477, 491.

This Court's decision in the *Altoona* case had nothing whatever to do with reissues, and the appellate court embarks on a dangerous course when it stretches the quoted statement to mean that when a broad original claim is disclaimed from a reissue patent, the original patent must thereafter be construed as if no part of the subject matter of the broad claim was ever intended to have been covered.

Original claim 5, for the reason that it did not include any kind of an operating member whatever, thus constituted indisputable evidence in the original patent that the

patentee did not regard the operating member as one of the essential elements of his invention and that he did not consider himself limited to the particular type of operating member shown in the lever-operated embodiment illustrated in the patent. Explaining that it was dating the disclaimer back to the original patent and ignoring claim 5, the appellate court said in the *Associated* decision that the reissue claims must include levers in order to be for the same invention as the original patent.

The Oklahoma court did not go along with the Court of Appeals for the Ninth Circuit in its reasoning that the reissue claims are not for the same invention as the original patent unless they include levers. Finding 7 of the Oklahoma court [R. Vol. I, p. 54] was as follows:

> "7. The reissue patent No. 20,827, and especially claims 7, 8, 9, 10 and 11 thereof, are for the same invention as patent 2,108,538; and it appears, from the face of the said patent 2,108,538, that plaintiff intended to claim the invention now claimed by claims 7, 8, 9, 10 and 11 in the reissue patent No. 20,827."

There is thus a conflict on this point between the Court of Appeals for the Ninth Circuit and the District Court within the Tenth Circuit. Regardless of whether or not the judgment of the latter court is affirmed, this important point of patent law should be passed on by this Honorable Court because of its departure from established doctrine and the statutes and because of the far-reaching effects that it may have.

If the disclaimer of a broad claim from a reissue patent is to be made retroactive to the original patent as to all of its subject matter, which is the effect of the *Associated* decision reaffirmed here, then any patent that has been reissued to secure narrower claims can at any later time be converted into an invalid reissue merely by disclaiming one of the broad claims that was held over from the original. If this is to be the law of the land, the validity of a reissue can never be finally determined, and the decision of the Commissioner of Patents or of any court including the Supreme Court can be upset at any subsequent time merely by the disclaiming by the patentee of a broad reissue claim that had appeared in the original patent.

Many courts require that a patentee disclaim a broad claim if it is found to include more than he had a right to claim, but the Ninth Circuit ruling is to the effect that if such a claim is in a reissue patent, the disclaimer, in construing the patentee's original intent, must date back to the original patent, thereby creating a situation in which the remaining reissue claims are no longer for the same invention as the original unless they are restricted to the exact structure set forth in the original claims that were not involved in the disclaimer.

There are thus at least five reasons why this Honorable Court should grant this petition. Four of these reasons are of such a nature that the petition should be granted irrespective of whether the judgment of the United States District Court for the Western District of Oklahoma is affirmed by the Court of Appeals for the Tenth Circuit.

Prayer for the Issuance of the Writ.

Wherefore, your petitioner prays that a writ of certiorari issue under the seal of this Court, directed to the Court of Appeals for the Ninth Circuit, commanding said court to certify and send to this Court a full and complete transcript of the record of the proceedings of the said court had in the case numbered and entitled Docket No. 11652, LeRoy J. Leishman, appellant, v. Radio Condenser Company and General Instrument Corporation, appellees, to the end that this cause may be reviewed and determined by this Court as provided by the statutes of the United States; and that the judgment herein of said Court of Appeals for the Ninth Circuit be reversed by the court, and for such other relief as to this Court may seem proper.

Dated this 26th day of October, 1948.

LeRoy J. Leishman,
Petitioner, in Propria Persona.

Certificate.

This petition is in my judgment well founded, and is not interposed for delay.

LeRoy J. Leishman,
Petitioner, in Propria Persona.

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OCTOBER TERM, 1948.

No. .....

LEROY LEISHMAN,

Petitioner,

vs.

RADIO CONDENSER COMPANY and GENERAL INSTRUMENT CORPORATION,

Respondents.

BRIEF IN SUPPORT OF PETITION.

I.

PUBLICATION OF OPINIONS OF LOWER COURTS.

The opinion in the District Court was an unreported memorandum opinion, but the findings of fact may be found in Vol. I of the record, beginning on page 86.

The opinion in the Court of Appeals for the Ninth Circuit [R. Vol. III, pp. 285 *et seq.*] is reported in 167 F. 2d 890.

II.
BASIS OF JURISDICTION.

The judgment was rendered on a motion for summary judgment in an action brought under the Declaratory Judgment Act [Sec. 274-D of the Judicial Code, 28 U. S. C., Paragraph 40 (before the recent revisions)] and patent statutes of the United States.

Jurisdiction of this Court is invoked under Section 240 of the Judicial Code, corresponding to Title 28, U. S. C. A., Paragraph 1254; and also under Rule 38(5b) of the Rules of the Supreme Court.

III.
STATEMENT OF THE CASE.

Petitioner seeks a review of the decision of the Court of Appeals for the Ninth Circuit affirming a summary judgment of the District Court to the effect that respondents' devices do not infringe claims 7 to 11 of petitioner's reissue patent No. Re. 20,827.

The summary judgment of the lower court was based upon the doctrine of *stare decisis,* following the appellate court's ruling in the case of *Leishman v. Associated Wholesale Electric Company,* 137 F. 2d 722.

In affirming the lower court's judgment, the appellate court affirmed and adopted its earlier decision [R. Vol. III, p. 263].

In the *Associated* case, the lower court decided only that the claims were invalid for want of invention. It rendered no opinion on the issue of infringement and made no findings that were pertinent to infringement (36 Fed. Supp. 804). The Court of Appeals wiped out the holding that the claims were invalid for want of invention, but decided

de novo the issue of infringement without any findings from the lower court on this issue. Such judicial procedure, according to the Court of Appeals for the Sixth Circuit, violates both the letter and spirit of Rule 52.[8]

In the instant case, the only finding that supported the lower court's *summary* judgment of non-infringement, was finding 18, which read as follows [R. Vol. I, p. 91]:

> "18. No evidence has been presented to the court by defendant which could in any manner change or affect the ruling of the Circuit Court of Appeals in the aforesaid [Associated] case that plungers and levers in the alleged patented combination do not function in the same way, or in substantially the same way, and are therefore not equivalents."

Without allowing petitioner the opportunity of adducing evidence at a trial to prove that the *Associated* decision was in error, the lower court merely followed the *Associated* decision of non-infringement which was rendered without any findings of fact. In the instant case, the lower court thus made no findings on the merits of this issue, but merely a finding that there was no evidence in

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[8]"The record discloses, however, that no opinion was expressed, no findings of fact were filed, and no conclusions of law were stated by the District Court with respect to the validity of the patent claims in issue. Nevertheless, the appellant urges that this court should pass upon the validity of the claims of the MacDonald patents. We cannot agree that such procedure would be appropriate.

* * * * * * * *

"* * * Without findings of fact from the trial court, the reviewing court would, in our judgment, violate both the letter and spirit of Rule 52 in passing upon a controverted issue of fact [in the instant case the validity of a patent] not determined in the trial court." *Hazeltine Corporation v. Crosley Corporation*, C. C. A. 6, 130 F. 2d 344, at 349.

the summary judgment proceedings that would in its judgment change the opinion of the appellate court in the former case.

The Court of Appeals has now affirmed the lower court's judgment. Inasmuch as the appellate court's opinion is a mere affirmance of the *Associated* opinion, we thus have a *second* decision arrived at without any findings of fact on the merits of the infringement issue. The decision is to the effect that the first opinion, arrived at without findings, was correct, and that petitioner may not be given a trial to contest the soundness of the first abortive opinion.

The United States District Court for the Western District of Oklahoma, in rendering judgment in petitioner's favor on June 10, 1946, made complete findings, of which findings 6, 11, 12, 17, 26 and 27 were directed to the issue of infringement [R. Vol. I, pp. 55 *et seq.*].

Petitioner moved to amend the pleading [Vol. I, pp. 72 *et seq.*] in order to make the additional defense that respondents herein were bound by the Oklahoma judgment because of their participation in the defense of that action, but his motion was denied [R. Vol. I, p. 134].

The summary judgment herein was entered on September 12, 1946 [R. Vol. I, pp. 94 *et seq.*]. It was thus rendered in direct conflict with the judgment of the Oklahoma court which arrived at its findings after a full trial.

The Oklahoma action was defended by the Galvin Manufacturing Company, makers of the radio sets that included the accused tuners manufactured by respondents herein. Finding 3 of the Oklahoma court [R. Vol. I, p. 53] was to the effect that the Galvin Manufacturing Company was bound by the judgment.

The lower court in the instant action enjoined petitioner from any litigation involving respondents' customers [R. Vol. I, pp. 98 *et seq.*], but the injunction was modified to permit petitioner to defend the appeal from the Oklahoma judgment and to permit him to proceed against the Oklahoma defendant's privy, the Galvin Manufacturing Company.

The Court of Appeals for the Ninth Circuit modified the judgment by removing petitioner's right to proceed against the Galvin Manufacturing Company [R. Vol. I, p. 266].

On the issues of the case, the major conflict between the courts in the Ninth and Tenth Circuits is whether infringement of petitioner's claims may be avoided by using a plunger instead of a lever to operate or transmit motion to the elements within the radio set that do the actual work of petitioner's combination. The ruling of the Court of Appeals for the Ninth Circuit on this point will be found at the close of its controlling opinion in the *Associated* case, *supra,* and the contrary view of the Oklahoma court is expressed in findings 6, 11, 12 and 16 [R. Vol. I, pp. 53, 55, 56].

One of the subsidiary questions enumerated in the petition has to do with whether the disclaimer of a broad claim from a reissue patent which also appeared in the original patent, can retroactively change the surrendered original patent and thereby create a situation in which the regularly granted *reissue* patent is no longer for the same invention as the original.

The reissue patent here at issue added six new claims, of which claims 7 to 11 were involved in the Oklahoma and California cases. Like claim 5 of the original patent, which was retained in the reissue, reissue claims 7 and 8 did not include any kind of an operating member as one of its elements, and claims 9, 10 and 11 claimed the operating member broadly as a "manually operable member" or "manually operable means." Seventeen months after the reissue was granted, claim 5 was disclaimed because it was broad enough to read on devices not invented by petitioner, but the narrower claims were retained because they included novel and patentable structure.

Ordinarily, the disclaimer of a broad claim does not affect the patentably different narrower claims, and the result of the disclaimer is merely to relinquish the patentee's right to that part of the scope of the broad claim which is in excess of the narrower claims retained. But claim 5 happened to be the only claim in the original patent that did not include a lever, and the Court of Appeals for the Ninth Circuit held that since this Honorable Court had said the disclaimer speaks from the date of the original patent, claim 5 could not be considered when examining the original patent to see if the patentee originally intended to cover a combination not restricted to lever operation. The far-reaching effect of this ruling was mentioned in the petition under Reasons Relied Upon for Allowance of the Writ, and it will be further discussed in the Argument.

IV.

SPECIFICATION OF ERRORS.

1. The Court of Appeals for the Ninth Circuit erred in holding that respondents' tuners do not infringe claims 7 to 11 of patent No. Re. 20,827.

2. The Court of Appeals for the Ninth Circuit erred in holding that a plunger is not the equivalent of a lever in the operation of the combinations set forth in the claims here at issue.

3. The Court of Appeals for the Ninth Circuit erred in affirming a summary judgment granted in direct conflict with the judgment of another federal court rendered after a full trial.

4. The Court of Appeals for the Ninth Circuit erred in affirming a summary judgment based solely upon the doctrine of *stare decisis*.

5. The Court of Appeals for the Ninth Circuit erred in failing to consider claim 5 of the original patent when examining the said patent to determine whether the reissue was granted for the same invention as that intended to have been claimed in the original.

6. The Court of Appeals for the Ninth Circuit erred in holding that the reissue claims are not for the same invention as the original claims unless they include levers.

7. The Court of Appeals for the Ninth Circuit erred in misapplying a ruling of this Honorable Court in *Altoona Publix Theatres v. American Tri-Ergon Corp.* to form a basis for its unprecedented opinion that an original claim which has been disclaimed from the reissue must be ignored when considering the intent of a patentee to cover the combinations covered by the remaining reissue claims.

8. The Court of Appeals for the Ninth Circuit erred in modifying the injunction of the lower court so that petitioner is no longer permitted to proceed against the privy of the defendant in the Oklahoma action which was decided in petitioner's favor.

9. The Court of Appeals for the Ninth Circuit erred in affirming the lower court in its denial of petitioner's motion for permission to file a supplemental answer alleging that respondents were bound by the Oklahoma judgment because of their participation in the defense of that action.

V.
ARGUMENT.

A. This Honorable Court Should Resolve the Conflict on the Issue of Infringement.

Rule 38(5b) of this Honorable Court provides that the court will resolve a conflict between the courts of appeal of different circuits in patent cases. That practice has been followed too often to require a citation of the cases in which a writ of certiorari was issued for this purpose.

At present the conflict is between the Court of Appeals for the Ninth Circuit and the United States District Court for the Western District of Oklahoma, but it is expected that the Court of Appeals for the Tenth Circuit will render its opinion on the appeal from the Oklahoma case within a month. If the decision is affirmed, the conflict will be between the appellate courts.

Irrespective of any action by the Court of Appeals for the Tenth Circuit, the nature of the holding of non-infringement in the Ninth Circuit is such that certiorari should be granted to avoid the serious consequences of a

radical departure from this Honorable Court's rulings that infringement of a patented combination cannot be avoided by substituting a well known mechanical equivalent for one of the elements of the combination.

The doctrine with respect to equivalents was settled long ago in the Supreme Court case of *Seymour v. Osborne,* 11 Wall. (78 U. S.) 516 at 556, 20 L. Ed. 33 at 42, wherein the court said:

> ". . . Mere formal alterations in a combination in letters patent, however, are no defense to the charge of infringement, and the withdrawal of one ingredient from the same and the substitution of another which was well known at the date of the patent as a proper substitute for the one withdrawn, is a mere formal alteration of the combination if the ingredient substituted performs substantially the same function as the one withdrawn."

In the instant case, the function of the lever and the function of the plunger are not merely *substantially* the same; they are *identical.* The function in both cases is to move an adjustable *tappet* member referred to in the claims as an "adjustably mounted positioning element" or "means adjustably movable about a pivot." And plungers were not only "well known at the date of the patent as a proper substitute" for a lever, but these mechanical devices were, and still are, the most commonly encountered of all mechanical equivalents.

An abundance of evidence of the well known equivalency of levers and plungers was presented with the Affidavit of LeRoy J. Leishman Filed in Behalf of Defendant [R. Vol. I, p. 46], but their equivalency is so well known

that this Court may readily take judicial notice of the fact without even referring to the record. Cash registers are operated either by plungers (push buttons) or by levers. Trumpet and trombone players play their instruments by pressing on plungers, while the clarinet and saxaphone players are operating short levers. Bicycle pumps are operated by plungers, but the family water pump on the farm was operated by a long lever, or handle. The usual pay telephone is switched out of circuit at the close of the conversation by hanging the receiver on the end of a lever, while a desk set is switched out of circuit by placing the receiver on the plunger or plungers in the cradle where the receiver rests when the instrument is not in use. Such examples could be multiplied indefinitely.

Vol. II of the record contains copies of ten patents on plunger-operated devices in this art that were known when the patent office granted the original patent that was reissued as the patent here in suit. One of these patents shows the *alternative* use of a plunger and a lever for operating a tappet in an electric clock in 1883 [Kettell, R. Vol. II, pp. 178 *et seq.*], and two of them illustrate the *optional* use of plungers or levers in automatic tuners before petitioner's original patent was granted [Danish patent, R. Vol. II, p. 255; and Peck, R. Vol. II, pp. 238 *et seq.*, Figs. 2 to 5]. In Peck's 1932 tuner, the operating member is attached at a pivot 20, and he says [p. 242, lines 69-71]. "Various expedients may be adapted to cause the downward movement of the pivot 20." Peck illustrates manually operated *levers* in Figs. 3, 4 and 5, and elec-

trically operated *plungers* in Fig. 2. But when "various expedients"—plungers or levers—are used to operate the combination claimed in petitioner's patent five years later in 1937, the Court of Appeals for the Ninth Circuit says they are *not equivalents.*[4]

If this decision is allowed to stand, any patent on a lever-operated device can be avoided merely by operating the same mechanism by a plunger.

The United States District Court for the Western District of Oklahoma ruled in accordance with this Honorable Court's decisions with respect to the substitution of equivalents, saying [R. Vol. I, p. 55]:

> "11. The tappet or positioning element described in plaintiff's reissue patent No. 20,827 may be mounted either on a lever or a plunger to move the tappet, since a lever and a plunger perform their functions in the same way and are mechanical equivalents.
>
> "12. The finding 11 is based not only upon the evidence offered on behalf of plaintiff, but also upon the direct testimony of defendant's expert, Dr. Spotts, who testified to the effect that the substitution of plungers for levers is a simple one in the combination covered by claims 7, 8, 9, 10 and 11 of the said reissue patent."

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[4]The rule properly applicable here has been expressed by this Honorable Court as follows: "That which is common and well known is as if it were written out in the patent and delineated in the drawings." *Webster Loom Co. v. Higgins,* 105 U. S. 580, 586.

B. The Declaratory Judgment Act Enables Any Infringing Manufacturer to Bring Suit Against Petitioner in the Ninth Circuit, Where a Second and Third Suit Are Now in the Courts; and This Honorable Court Should Therefore Decide the Issue of Infringement Now for the Benefit of the Entire Radio Industry.

In *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U. S. 477, the litigation on the patent involved was centered in a single circuit, and this Honorable Court therefore granted certiorari despite the fact that there was no conflict between circuits. In *Mackay Radio and Telegraph Company, Inc. v. Radio Corporation of America,* 306 U. S. 86, 59 S. Ct. 427, 83 L. Ed. 506, there were only two possible litigants, and certiorari was granted because an opinion of this Court would therefore settle the controversy for the entire industry as thus constituted.

Despite the fact that petitioner provided a forum in the Tenth Circuit in which to decide whether respondents' tuners were infringements, respondents refused to intervene there but forced the present controversy in the Ninth Circuit in order to get a rubber-stamped decision based upon the earlier opinion in the *Associated* case. When the district court in Oklahoma decided the *Richards and Conover* case in petitioner's favor, General Motors Corporation, which also uses petitioner's patented combination, made it impossible for petitioner to get a decision against it in another circuit by hurriedly filing a declaratory judgment suit in the U. S. District Court for the Southern District of California, Central Division, Civil Action No. 5781-M. The latter case was recently tried, but no opinion has yet been rendered.

Finding 25 in the Oklahoma action [R. Vol. I, p. 59] showed that tuners of the type here involved "were supplied to the public in approximately 8,000,000 radio sets up to April, 1942." Of this number, about 7,000,000 were made by respondents. In the automotive field, General Motors admitted having made about one million tuners of this type up to 1948. The litigation in the Ninth Circuit thus involves by far the major portion of the tuners that have been made embodying petitioner's combination, and the Supreme Court should therefore decide the issues for the radio industry as a whole.

C. The Court of Appeals for the Ninth Circuit Has Granted a Summary Judgment on Grounds Held Insufficient by Other Federal Courts.

It has already been pointed out in the Statement of the Case that the summary judgment in the instant case is the first that has ever been granted in direct conflict with the judgment of another federal court rendered after a full trial.

When such a summary judgment was proposed in another district court, its propriety was condemned in no uncertain terms by the court, as follows:

> "Furthermore, although the court cannot in the circumstances say that the issue is *res judicata,* the fact that the patent was approved by a court of competent jurisdiction after a full trial (Cold Metal Process Co. v. United Engineering & Foundry Co., D. C., 3 F. Supp. 120) would make it almost presumptuous for this court to declare the patent invalid upon nothing more than a comparison of documents which had been before the other court. * * * Motion overruled." *E. W. Bliss Co. v. Cold Metal Process Co.,* 47 Fed. Supp. 897, at 899.

Regarding the circumstances in which summary judgment is proper, the Court of Appeals for the Eighth Circuit said in the case of *Ramsouer v. Midland Valley R. Co.,* 135 F. 2d 101, 106:

> "In considering such a motion as in a motion for a directed verdict, the court should take that view of the evidence most favorable to the party against whom it is directed, giving to that party the benefit of all favorable inferences that may reasonably be drawn from the evidence. If, when so viewed, reasonable men might reach different conclusions, the motion should be denied and the case tried on its merits."

When the summary judgment was rendered in the instant case, it had already been definitely proved that "reasonable men might reach different conclusions," for the Oklahoma court had just previously held after a full trial that the claims here at issue were clearly valid and clearly infringed by respondents' tuners [Oklahoma Findings 6 and 26, R. Vol. I, pp. 53, 59].

Holding a view regarding summary judgments radically different from that of the Court of Appeals for the Ninth Circuit, the Court of Appeals for the Second Circuit said in the case of *Arnstein v. Porter,* 154 F. 2d 464 at 471:

> "Illustrative of the dangers, in this respect, of summary judgment, if not cautiously employed, is a recent case in the court below. There the judge refused to grant summary judgment for defendants, despite a mass of impressive affidavits, containing copies of corporate records, the accuracy of which plaintiffs did not deny in their affidavits, and which on their face made plaintiffs' case seem nothing but a sham; at the trial, however, cross-examination of

the defendants revealed facts, theretofore unknown by plaintiffs, that so riddled the defendant's case as it had previously appeared on the summary judgment motion that the judge entered judgment against them for several million dollars, from which they did not appeal."

In the recent case of *Associated Press et al. v. United States,* 326 U. S. 1, 6, 65 S. Ct. 1416, 1418, the Supreme Court said:

> "We agree that Rule 56 should be cautiously invoked to the end that parties may always be afforded a trial where there is a *bona fide* dispute of facts between them."

This Honorable Court's remarks in the case of *Sartor et al. v. Arkansas Natural Gas Corporation,* 321 U. S. 620, 627, 64 S. Ct. 724, 728, are particularly in point here:

> "The Court of Appeals below heretofore has correctly noted that Rule 56 authorizes summary judgment only where the moving party is entitled to judgment as a matter of law, where it is quite clear what the truth is, that no genuine issue remains for trial, and that the purpose of the rule is not to cut litigants off from their right of trial by jury if they really have issues to try."

The action of the Court of Appeals for the Ninth Circuit in affirming a summary judgment in direct conflict with that of the Oklahoma court, which was rendered after a full trial, is thus in sharp contrast to the practice advocated by other courts of appeals and by this Honorable Court itself. The situation is clearly one that calls for an exercise of this Court's supervisory powers.

D. Summary Judgment Should Never Be Based Solely Upon the Doctrine of Stare Decisis.

The application of the doctrine of *stare decisis* presupposes that the evidence in the new case is like that in the old. This can never be determined, however, until the evidence is all in. Summary judgment should therefore never be rendered when the doctrine of *stare decisis* is involved, because it deprives the party against whom it is directed of the opportunity of adducing evidence different from that in the earlier case.

E. If an Original Claim That Is Disclaimed From the Reissue Must Be Ignored When Determining Whether the Reissue Claims Are for the Same Invention as the Original, the Validity of a Reisue Patent Can Never Be Finally Determined.

This Honorable Court has long ago held that a reissue must be for the same invention intended to have been claimed in the original, as such intention appears from the original document.[5] The original document must therefore be referred to for evidence of what the patentee intended to bring within the broad scope of his claims. Sometimes excellent evidence of this nature may be found in the original claims themselves. Whether certain narrow reissue claims are within the scope of the original patent, may therefore depend upon the examination of a broad original claim. Subsequent to the grant of the original patent, such original claim may be found to be

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[5]*Parker and Whipple Company v. Yale Lock Company,* 123 U. S. 87.

of such breadth that it includes more than the patentee had invented, and he may therefore drop the broad claim when obtaining the reissue. It is elementary, however, that this would in no way affect the patentee's right to the narrow reissue claims if they contained patentable subject matter. In the instant case, the patentee discovered seventeen months after the *reissue* patent was granted, that one of the claims held over from the original patent was too broad, and he immediately disclaimed it. The Court of Appeals for the Ninth Circuit, in the *Associated* case followed here, says that this claim (claim 5) must not be considered when examining the original patent, because the disclaimer "speaks from the date of the original patent," citing this Honorable Court's decision in the *Altoona* case, *supra*. If the claim had been dropped when the reissue was obtained, it would have been considered when examining the original patent for evidence of intent; but since the claim was dropped by a disclaimer, the appellate court says that "both the original patent and the reissue must be construed as if claim 5 had never been included in either." The latter statement would of course be true so far as holding an infringer is concerned, but the claim should nevertheless be examinable to see whether the subject matter of the narrower claims is within the scope which the patentee originally intended to claim, even though he may have claimed so much that it later seemed expedient to relinquish the broad claim and rely only upon the narrower ones.

The Ninth Circuit doctrine, if followed, will make it impossible for any patentee to disclaim a broad original claim after it has appeared in a reissue, because if the original patent is construed as if the broad claim had never appeared therein (as the appellate court contended in the *Associated* case), his narrower reissue claims will no longer be for the same invention as the original patent.

Claim 5 of the original and reissue patents did not include any kind of an operating member as an element of the combination, because it is immaterial how motion is transmitted to the tappet. The narrower claims of the ~~reissue~~ original referred to the operating member as a lever. Examining the original claims in the *Associated* case *without considering claim 5,* the appellate court said that all the original claims included a lever and that the reissue claims are therefore not for the same invention unless they include levers.

That the disclaimer of claim 5 on January 16, 1939, could not possibly have any retroactive effect upon the validity of the reissue on August 16, 1938, may be shown by a simple illustration. Suppose that claim 5 had not been disclaimed when the Ninth Circuit Court of Appeals rendered its opinion in the *Associated* case. The Court would then have considered claim 5 when comparing the original and reissue claims, and regardless of whether it held this claim valid or invalid, infringed or not infringed, the Court certainly could not have made its state-

ment that "No leverless combination is disclosed or claimed in the original patent," nor that "if the claims do not include levers, the claims are not for the same invention as the original patent and hence are invalid." The validity of the reissue would therefore have been upheld. Then suppose that claim 5 was subsequently disclaimed. Would that mean that the reissue which had previously been held valid had now become invalid? If so, the validity of a reissue can never be finally determined, and the decision of the Commissioner of Patents could be upset at any subsequent time merely by the disclaiming by the patentee of a broad reissue claim that had appeared in the original patent. This would be true even if this Honorable Court in the meantime had held that the reissue was valid.

Finding 7 of the Oklahoma court [R. Vol. I, p. 54], rendered before the Circuit Court of Appeals reaffirmed its *Associated* decision, has held that the claims of the reissue patent are for the same invention as that set forth in the original. There is thus a conflict between these courts.

Regardless of whether the Oklahoma decision is affirmed by the Court of Appeals for the Tenth Circuit, the Ninth Circuit ruling with respect to the effect of the disclaimer is of such a nature that its consequences can be serious and far reaching. This Honorable Court should therefore pass upon this new point of patent law.

F. The Lower Court Should Have Granted Petitioner's Motion for Permission to Amend the Pleadings.

Rule 15(a) of the Rules of Civil Procedure provides that permission to amend the pleadings be freely granted whenever justice so requires. Petitioner's proposed additional defense [R. Vol. I, pp. 72 *et seq.*] was that respondents were bound by the judgment in the Oklahoma case because they aided in the defense of that action. Not only was this a proper defense entitling petitioner to a trial, but acts of participation already known were verified by petitioner's Second Affidavit in Support of Motion Under Rule 15(d), dated July 8, 1948 [R. Vol. I, pp. 69 *et seq.*]. The appellate court's opinion in the instant case says [R. Vol. I, pp. 264-265], "These allegations were shown to be untrue by an affidavit of Maxwell James filed on July 8, 1946." It was petitioner's affidavit that was filed on July 8, 1946, and the record shows [pp. 66 *et seq.*] that the James affidavit was filed on June 28, 1946. It is difficult to see how Mr. James on June 28, 1946, could have made a denial of allegations not made until July 8, 1946, or why the James' affidavit would have had any more evidential value than that of Leishman.

Additional verification of some of respondents' acts of participation was filed as Defendant's Exhibit 17 [R. Vol. I, pp. 103 to 133], which was a portion of the transcript of the Oklahoma trial, verified by petition [p. 102]. The pertinent portions of the exhibit, and their pertinence, were pointed out in a brief filed with the exhibit.

The motion to file the supplemental answer was denied on December 18, 1946 [R. Vol. I, p. 134].

Evidence of participation is often adduced at a trial, and petitioner should have had the opportunity of thus supplementing the showing made in the affidavit.

If petitioner does not prevail on his other defenses, this Honorable Court should instruct the lower courts to see that he has his day in court on this additional defense that was denied him.

Conclusion.

It is therefore respectfully submitted that this case is one calling for this Court to resolve the conflicts herein set forth and to exercise its supervisory powers by granting a writ of certiorari and thereafter reviewing and reversing the decision of the court below.

LeRoy J. Leishman,
Petitioner in Propria Persona.